

HUBERT DORN ET AL.
USSN 09/780,646

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U.S. Patent No. 6,232,328, which is a continuation of U.S. Serial No. 08/440,428, filed May 12, 1995, now abandoned. --

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

The Examiner requested that the status of the parent application be updated in the specification. This has now been done. A mark-up showing the changes that have been made using brackets and underlining is attached.

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The only other issue is the rejection of claims 10-15 under 35 USC § 103(a) as being obvious over European Patent Application No. 0 285 985 and European Patent Application No. 0 259 738. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The present invention includes the dermal *non-systemic* application of the compounds of formula (I). Non-systemic means that the active ingredient is not distributed via the blood circulation. Although the Examiner points out that the cited references mention dermal applications, it is important for the Examiner to understand that dermal application may also lead to *systemic* action since active ingredients may penetrate through the skin. Consequently, dermal application is not necessarily identical to non-systemic application, and maintenance of this rejection requires that the Examiner show that the cited references taught or suggested non-systemic application specifically. Applicants submit that the cited references nowhere teach or suggest non-systemic application. Consequently, the Examiner should reconsider and withdraw this rejection.

To the best of Applicants' knowledge, at the time the present invention was made, persons skilled in the art would not have considered the non-systemic application of the compounds of the present claims in order to control ectoparasitic insects on animals or humans. In particular, such persons also would not have expected their surprisingly high efficiency over a

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long term. While referring to a different type of compounds, the introductory part of WO 93/24002, of record here, very well reflects the thinking of persons skilled in the art at that time. Although *dermal application* of active ingredients to animals was of course in principle known, WO 93/24002 discloses that for the compounds described therein only systemic application is suitable. Thus, *non-systemic* application was clearly regarded as being *unsuitable* for such compounds.

With regard to the prior art cited by the Examiner, Applicants disagree that these two documents render the present subject matter obvious.

EP-A-285 985 lists virtually all known application forms for veterinary medicine (see page 7, line 31 ff. of the German text). However, as all these application forms are listed without specific comments or preferences, the document offers no guidance as to which of these applications would be particularly suitable. Also, the document does not specifically mention non-systemic application of the respective compounds. Therefore, this document also does not lead the skilled person to Applicants' invention.

With respect to EP-A-259 738, the Examiner points to page 9, lines 35-42. However, Applicants point out that in line 36, the reference discloses that the compounds are active against endoparasites and ectoparasites, such as insects and worms. Obviously, endoparasites have to be

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treated by a method which brings the active compound into the body of the host animal, such as oral, parenteral or transdermal application methods. On the same page, at lines 43-48, the reference discloses suitable formulations for the active ingredients disclosed therein. However, the references does not specify for which purposes these formulations should be used.

Applicants submit that the reference does not give any hints as to which administration forms should be used in veterinary medicine. The document also does not highlight any differences in results between systemic and non-systemic application of the active compounds, but the present record shows there are clear, unexpected differences. See, again, the declarations of record.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

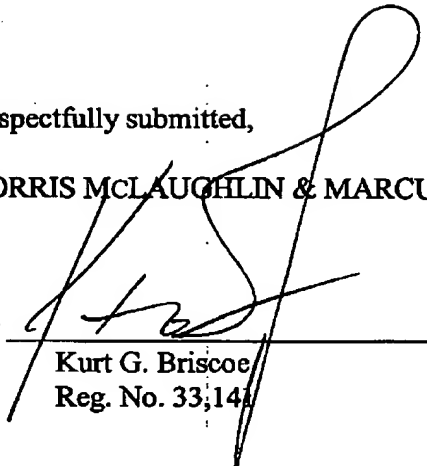
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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By


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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Mark-Up Showing the Changes Made in the Previous Claim to Yield the Claim as Amended Above and the accompanying Petition for Extension of Time (9 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: February 27, 2002

By


Kurt G. Briscoe

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MARK-UP SHOWING THE CHANGES MADE IN THE SPECIFICATION

First paragraph:

--This application is a division of U.S. Serial No. 08/925,372 filed on September 8, 1997, now
[pending;] U.S. Patent No. 6,232,328, which is a continuation of U.S. Serial No. 08/440,428,
filed May 12, 1995, now abandoned. --